

Appln. No. 09/911,522
Amendment dated December 15, 2005

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 10 remain in this application. No claims have been cancelled or withdrawn or added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 2 through 6 of the Office Action

The specification has been objected to for the informalities noted in the Office Action.

The specification has been amended in a manner believed to clarify any informalities in the language, particularly at the points identified in the Office Action.

Withdrawal of the objection is respectfully requested.

Paragraphs 7 through 8 of the Office Action

Claims 1 through 14 and 16 through 20 have been rejected under 35 U.S.C. §101 as claiming non-statutory subject matter.

Claims 1 and 16 have been amended in a manner that is submitted to overcome the concerns set forth in the Office Action regarding non-statutory subject matter.

Withdrawal of the 101 rejection of claims 1 through 14 and 16 through 20 is therefore respectfully requested.

Paragraph 9 through 18 of the Office Action

Claims 1 through 20 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

Appn. No. 09/911,522
Amendment dated December 15, 2005

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action. In particular, claims 1, 3, 4, 8, and 15 have been amended.

Withdrawal of the 112 rejection of claims 1 through 20 is therefore respectfully requested.

Paragraph 19 through 20 of the Office Action

Claim 5 has been rejected under 35 U.S.C. §112 (first paragraph) as allegedly failing to comply with the written description requirement.

The Examiner's attention is drawn to the specification, and more particularly to the portion of the specification at page 9, lines 17 through 27, where it is stated (emphasis added):

Each of the selected and configured databases is then again evaluated for relevance to the subject area. A sample query from the subject area is submitted to each of the selected databases. Responsive pages or documents are then gathered from each of the databases. These responsive documents are evaluated for relevance to the subject area. Each of the databases is assigned a numerical score representing relevance to the subject area. Databases with a sufficiently high numerical score are then qualified for use in the subject area. A different collection of databases may be qualified for each subject area. The qualified databases are then used for the next major function: document acquisition.

It is submitted that the specification, and particularly the portion of the specification set forth above, complies with the written description requirement. Claim 5 has also been amended to further clarify the requirements of claim 5.

Withdrawal of the 112 (first paragraph) rejection of claim 5 is respectfully requested.

BEST AVAILABLE COPY

Appn. No. 09/911,522
Amendment dated December 15, 2005

Paragraphs 21 through 29 of the Office Action

Claims 1, 8, 9, 12, 13, and 16 through 20 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Wu in view of the CSA document.

Claims 2 and 11 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Wu in view of the CSA document, and further in view of Ferguson.

Claim 3 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Wu in view of the CSA document, and further in view of Marks.

Claims 4 and 5 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Wu in view of the CSA document, Marks, and further in view of Kirsch.

Claims 6 and 7 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Wu in view of the CSA document, Marks, Kirsch, and further in view of Cristal.

Claim 10 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Wu and the CSA document, and further in view of Redfern.

Claim 14 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Wu and the CSA document, and further in view of Kirsch.

Claim 15 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Redfern in view of the Cristal.

Claim 1 requires, in part, "obtaining a candidate database listing having a plurality of databases each having a collection of content" and

Appn. No. 09/911,522
Amendment dated December 15, 2005

"acquiring a listing of a plurality of qualified databases from said candidate database listing by matching each one of a candidate databases to said plurality of subject area. ".

It is conceded in the Office Action that:

Wu does not explicitly disclose obtaining a candidate database listing having a plurality of databases each having a collection of content; and acquiring a listing of a plurality of qualified databases from said candidate database listing by matching each one of a candidate databases to said plurality of subject areas; submitting said query to said plurality of qualified databases.

It is then asserted that:

CSA teaches obtaining a candidate database listing having a plurality of databases each having a collection of content; and acquiring a listing of a plurality of qualified databases from said candidate database listing by matching each one of a candidate databases to said plurality of subject areas; submitting said query to said plurality of qualified databases (CSA, Databases & Collections).

Thus, the rejection relies upon the disclosure of the CSA document to show:

- [1] "obtaining a candidate database listing having a plurality of candidate databases each having a collection of content";
- [2] "acquiring a listing of a plurality of qualified databases from said candidate database listing by matching one of a candidate databases to said plurality of subject areas of information"; and
- [3] "submitting said query to said plurality of qualified databases".

However, it is submitted that the CSA document merely lists a number of databases that appear to be grouped according to the subject matter of the databases (although there is no explicit disclosure in the CSA document from the information provided that this is actually the case), but that there is no description of any "matching one of a candidate databases to said plurality of subject areas of information" to obtain "a listing of qualified databases". Nothing here suggests that the CSA system is capable of performing such matching of databases. Further, the CSA document does

BEST AVAILABLE COPY

Appn. No. 09/911,522
Amendment dated December 15, 2005

not disclose "submitting said query to said plurality of *qualified databases*", as the user clearly controls what databases to which the search term is submitted. It is therefore submitted that, one of ordinary skill in the art, considering the CSA document, would not understand that there is any matching of candidate databases to subject areas performed by the system. It is therefore submitted that the allegedly obvious combination of the Wu and CSA documents would not lead one of ordinary skill in the art to the claimed invention of claim 1, and similarly claim 16.

Further, the combination of Wu and the CSA document is asserted to be proper in the Office Action because (emphasis added):

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the search system of Wu by providing a list of candidate databases and submitting the query to a qualified database as disclosed by CSA. The motivation being to limit the search in the related area/database to improve the search time.

However, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. In re Sang Su Lee, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The Office Action states that the motivation to combine Wu and the CSA document is to "limit the search in the related area/database to improve the search time." It is respectfully submitted that given the actual teachings of the references, the cited motivation to combine is not found in the references themselves. The cited references do not state that their purpose or benefit is to provide the delivery of results in a short time. More particularly, it is noted that the CSA document does not include any discussion of why one would employ the database classification system shown therein, and in particular there is no mention of any time savings that might be achieved by the use of the CSA system, and thus it is submitted that one of ordinary skill in the art would not gather from the CSA patent

Appn. No. 09/911,522
Amendment dated December 15, 2005

that any time savings could be achieved by combination of its system with any existing system. Also, as the user of the CSA system controls or chooses which databases the search term is submitted to, the user is clearly in control of the relative time taken for the search, not the system. It is therefore respectfully submitted that the quoted statement from the Office Action is merely a conclusory statement of belief and not specific objective evidence of a motivation to combine.

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Wu and CSA document set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claim 1.

Still further, while it is noted that the Examiner has included a copy of the archive.org printout for the "csa.com" website, this does not establish that these particular pages (which were downloaded from the CSA website in 2005), were actually a part of the website prior to the filing of this patent application.

Claims 2 and 11 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Wu in view of the CSA document, and further in view of Ferguson.

Claim 2 requires, in part, "obtaining an exclusion list providing a plurality of *terms and sources* to inhibit associations for said step of acquiring a collection of responsive content" and "obtaining an inclusion list providing a plurality of *terms and sources* restricting associations for said step of acquiring a collection of responsive content" (emphasis added).

It is conceded in the Office Action that:

... neither Wu nor CSA teaches obtaining an exclusion list providing a plurality of terms and sources to inhibit associations for said step of acquiring a collection of responsive content; obtaining an inclusion list

Appln. No. 09/911,522
Amendment dated December 15, 2005

providing a plurality of terms and sources restricting associations for said step of acquiring a collection of responsive content.

But it is then contended in the Office Action that (emphasis added):

Ferguson teaches obtaining an exclusion list providing a plurality of terms and sources to inhibit associations for said step of acquiring a collection of responsive content; obtaining an inclusion list providing a plurality of terms and sources restricting associations for said step of acquiring a collection of responsive content (Ferguson, col. 9, lines 1-15).

The Ferguson patent is generally directed to a document management system for managing discrete static documents on a database. Looking to the referenced portion of the Ferguson patent at col. 9, lines 1 through 15, it is stated that (emphasis added):

With respect to semi-automatic and automatic categorization, there are two filter types associated with each smart folder. The first filter type generates an inclusion list. The inclusion list identifies those documents that were not automatically included in the category associated with the smart folder during the categorization process. The inclusion list may provide the user with an indication that the category criteria associated with that category are too restrictive. The second filter type generates an exclusion list. The exclusion list identifies those documents that were not automatically excluded from the category associated with the smart folder during the categorization process. The exclusion list may provide the user with an indication that the category criteria associated with that category are not restrictive enough (i.e., the category criteria is too aggressive). Both lists are manually manipulated by the user. Accordingly, the user can modify the two lists as needed.

As can be appreciated from the words of the referenced portion of the Ferguson patent reproduced above, this portion of the Ferguson patent in particular refers to an inclusion list that relates to "documents" (and not "terms and sources") and an exclusion list that relates to "documents" (and also not "terms and sources"). It is submitted that one of ordinary skill in the art, considering the referenced portion of the Ferguson patent, would not be led to the requirements of claim 2, particularly the requirements that "an exclusion list providing a plurality of *terms and sources*" and "an inclusion

BEST AVAILABLE COPY

Appl. No. 09/911,522
Amendment dated December 15, 2005

List providing a plurality of *terms and sources*" by its description of lists that are specifically directed to *documents*. Clearly, the Ferguson patent does not describe a system in which an inclusion list or an exclusion list includes "terms", and similarly the Ferguson patent does not describe a system in which an includes list or an exclusion list includes "sources". At most, the lists in Ferguson include specific documents of the documents contained on the database, and this does not suggest that these lists extend to "terms" or "sources".

With respect to claim 3, it requires, in part, "capturing an initial page from each one of said plurality of candidate databases", "evaluating said initial page for relevance to said each one of said subject areas of information", and "selecting databases according to relevance to said subject areas of information".

It is conceded in the Office Action that Wu and CSA do not explicitly teach[] capturing an initial page from each one of said plurality of candidate databases; evaluating said initial page for relevancy to said each one of said subject areas.

But it is then contended that:

Marks teaches capturing an initial page from each one of said plurality of candidate databases; evaluating said initial page for relevancy to said each one of said subject areas (Marks, page 5, [0050]).

However, turning to the referenced portion of the Marks published patent application at paragraph [0050], it states:

[0050] In one embodiment, the document manager 500 includes a document profile unit 520. The document profile unit 520 receives a copy of the document that constitutes the document requested by the local computing resource. The document profile unit 520 obtains, generates and formats meta data relating to the content of each document that has been requested and allows the document transmission unit 510 to determine where and how to transmit the documents. According to a first embodiment of the present invention, the document profile unit 520 reads and re-formats recognized meta tags in the document that were placed there by the original publisher

Appln. No. 09/911,522
Amendment dated December 15, 2005

of the document and provide subject matter, size, source, rating, keyword, or other information relating to the document and forwards the meta data to the document transmission unit 550. According to a second embodiment of the present invention, the document profile unit 520 reads the content of the document to determine relevant subject matter, size, source or other information relating to the document and forwards the meta data to the document transmission unit 550. In another example, the document profile unit 520 may also interface with the master proxy server 380 (shown in FIG. 3) on the network communications interface to determine if the document being requested by a user has been "popular" with a specific class of local computing resources and forwards this meta data to the document transmission unit 550. According to this embodiment of the present invention, the document profile unit 520 may generate its own meta tags in its own format that are transmitted with the document or in some other way append or associate its aggregated formatted meta data to the source document. Some of the data, like source information, could be evaluated even before the document is received and help speed the evaluation process. For example, an excluded source could redirect to a unicast reply even before the source document arrives for evaluation by the other units. The meta tags may be transmitted in the header of the document, the body of the document, or using other techniques.

Significantly, nothing here indicates that an *initial page* is evaluated for relevancy to the subject areas. If anything, the Marks system appears to consider the entire document, which greatly increases the time required to analyze the document, and does not provide the relative efficiency of the claimed invention.

With respect to claims 4 and 5, each depends from claim 3 and therefore it is submitted that the foregoing remarks regarding claim 3 also apply to claims 4 and 5.

It is submitted that the Wu, CSA and Marks documents, either alone or in combination, would not lead one of ordinary skill in the art to the selection of the database from the candidate databases (based upon an initial page of each of the databases), as set forth in claim 3, especially in combination with the "qualification" of a portion of the selected databases based upon the quality of the responsive content returned by the selected

BEST AVAILABLE COPY

Appln. No. 09/911,522
Amendment dated December 15, 2005

databases generated as a result of submitting the query to the selected databases. None of the cited patents leads one of ordinary skill in the art to a process of at least two stages in which an initial page of a database is first examined, and then results from a search of the database is examined.

Withdrawal of the 103(a) rejections of claims 1 through 20 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHUJ TZ & SMITH P.C.


Jeffrey A. Proehl (Reg. No. 35,987)
Customer No. 40,158
P.O. Box 5027
Sioux Falls, SD 57117-5027
(605)336-3890 FAX (605)339-3357

Date: 12/15/2005

BEST AVAILABLE COPY